

Application No. 09/784,148
Amdt. Dated September 7, 2004
Reply to Office Action of April 8, 2004

Remarks and Arguments

Reconsideration is hereby requested, as is a one month extension of time, within which to respond to the non-final Official Action. The Small Entity extension of time fee for two months in the amount of \$210.00 is to be charged to Deposit Account No. 502557.

Claims 1, 12, 18, and 20 are rejected under 35 U.S.C. 112, second paragraph, "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Claims 1, 12, 18, and 20 have been amended herewith to clarify and provide proper antecedent basis.

Claims 1, 15-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being obvious over Allard et al. in view of Katz et al. A determination under 35 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obvious determination is based on certain underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

It is important to note that, for an application to be rejected under §103, one must identify the claimed elements, determine their meaning in light of the

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specification and prosecution history, and identify those same elements in the anticipating reference. *Genzyme Corp. v. Atrium Med. Corp.*, 315 F. Supp. 2d 552; 2004 U.S. Dist. LEXIS 10984, 21 (2004). It is error to treat the claims as a mere catalog of parts, disregarding part-to-part inter-relationships that give claims their meaning. *Id.* Experts often use the same words to describe the same device and a prior art reference. *Id.* However, whether the terms are used in different ways to connote different intended functions is often the issue. *Id.* The prior art cannot anticipate or render obvious a claim simply by possessing identically named parts, unless these parts also have the same structure which *function in the same way to achieve the same or a related result.* [Emphasis added] *Genzyme* at 21.

In line with this standard, case law provides that a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999). The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success for the intended purpose. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988). The mere fact

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that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

With regard to Claims 1, 15-17, and 19-20, Allard et al. teaches a method online retail shopping comprising steps of assigning a profile to each customer, selecting a product from search mode and utilizing an intelligent shopping cart. Katz et al. there is a combination of elements of continuously providing views of product alternatives and selecting from suggestion categories consisting of product information. Both Allard et al. and Katz et al. incorporate a remote system of use. Allard et al. is to be used from a personal computer accessing online retail shopping. (Column 1, Lines 7-10). Katz et al. is also remotely accessed, electronically and telephonically. (Column 1, Line 10). However, the Applicant's TOTALSHOP system does not require remote use. That is, the customer has primary access to a computer station when he or she is physically present in a retail store. In-store computer stations in turn guide the customer to a particular department and/or product.

The Examiner takes Official Notice of the e-commerce computer programming applications described above. However, in a typical notice situation, it is necessary to take notice of facts used to supplement or clarify the teaching of a reference or disclosure or to justify or explain a particular inference to be drawn from a reference. Facts so noticed serve to "fill in the gaps" which

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might exist in the evidentiary showing of references to support a particular ground for rejection.

In re Alhert, 424 F.2d 1088, 1092 (CCPA 1970). *Alhert* follows *In re Knapp-Monarch Company* in that judicial notice permits proof by evidence to be dispensed with where common knowledge supports the truth of a proposition. 296 F.2d 230 (CCPA 1961). Judicial notice may also be taken of facts "though they are neither actually notorious nor bound to be judicially known, yet they would be capable of such instant and unquestionable demonstration, if desired, that no party would think of imposing a falsity on... [then] in the face of an intelligent adversary. *Id.* However, in this matter the subject of the Examiner's official notice does not clarify or explain any reference.

Deficiencies of cited references cannot be remedied by the Examiner's general remarks about what is "basic knowledge" or "common sense." *In re Zurko*, 258 F.3d at 1379,1385 (CCPA 2001). Although e-commerce is old, all computer programming applications are not the same. E-commerce computer programming applications are certainly not all the same and these programming applications continue to evolve as various needs of businesses change.

The Applicant's TOTALSHOP system is essentially an intranet and, thus, is different from the basic e-commerce computer programming applications judicially noticed by the Examiner. Applicant's system is tailored specifically to each customer and requires a physical presence of both the customer and

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hardware in the retail location. Any remote use of the system is tangential to its underlying purpose. Neither Katz nor Allard teach intranets intended primarily for use inside of a physical retail location. Nor do they even address this application as an issue or object. In TOTALSHOP, profile is created in accordance with how much information the customer chooses to input. The information provided by the customer is not used to upsell, as in Katz et al. (Column 8, Lines 58-59). The Applicant's TOTALSHOP system provides alternatives to products in terms of size, color, design, coordinates, quantity, age, lifestyle, budget, and region. These alternatives are based on the national inventory of the chain of the store in which the customer is physically present. No art of record, or officially noticed, has a capability related to the TOTALSHOP system, which clearly, defines an original business method, i.e., a more efficient means of in-store retail shopping. As such, the same function is not achieved in the art through either the same method or any other suggested thereby. See *Genzyme Corp.*, supra.

In view of the above, Claims 1-20 should be allowable over all art of record. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1-20, as amended.



Date of Signature

Respectfully submitted,
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